

REMARKS

In the Office Action mailed July 25, 2007 from the United States Patent and Trademark Office, the Examiner rejected claims 1, 4, 5, 8, 10, 29, 33, 35-38, and 46-48 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,124,094 to Kobayashi et al. (hereinafter “Kobayashi”) in view of U.S. Patent No. 6,952,780 to Olsen et al. (hereinafter “Olsen”). The Examiner also rejected claims 7 and 34 under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi and Olsen in view of U.S. Patent No. 6,618,566 to Kurijai et al. (hereinafter “Kurijai”), rejected claims 8 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi and Olsen in view of U.S. Patent No. 6,385,675 to Yamaguchi (hereinafter “Yamaguchi”), rejected claims 11-13 and 39-41 under 35 U.S.C. 103(a) as being unpatentable over Kobayashi and Olsen in view of Applicant’s specification, and rejected claims 14, 16, 18, 20, and 42-45 under 35 U.S.C. 103(a) as being unpatentable over Kobayashi and Olsen in view of U.S. Patent No. 5,602,974 to Shaw, (hereinafter “Shaw”). Accordingly, Applicant respectfully provides the following:

Claim 29 is currently amended.

Claims 49 and 50 are new.

M.P.E.P. § 2141 sets forth the *Graham* factual enquiries that should be considered when making an obviousness rejection under Section 103: “Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.” (Citing *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).) Additionally, one helpful standard for a Section 103 rejection is set forth in M.P.E.P 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(Emphasis added). Applicant respectfully submits that the references cited in the Office Action, alone or in combination, do not teach or suggest the limitations claimed in the present claim set.

Applicant therefore respectfully submits that upon consideration of the *Graham* factual enquiries of the scope and content of the prior art and the differences between the prior art and the claims at issue, the claims cannot be found obvious. In the new obviousness guidelines published by the Office in the Federal Register dated October 3, 2007, the various rationales for finding obviousness require findings that the claimed elements were taught in the prior art or the Office must explain why the differences between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. For the below reasons, Applicant respectfully submits that no such findings or showings have been made, and that therefore the claims have not been shown to be obvious.

Independent claim 1 requires: receiving a request from a user to render a print job; spooling data of the print job to a spooler . . . using a print subsystem component to authenticate the user and an account of the user, . . . using the print subsystem component to parse the spooled data and determine a layout and a number of pages of the print job; using the print subsystem component and the parsed data to determine a cost for consumables to render the print job, wherein the cost for consumables is determined prior to despooling print data of the print job to

the printing device; using the print subsystem component to determine an amount of available funds in the user's account; and if the amount of available funds exceeds the cost for consumables, using the print subsystem component to debit the cost of the print job from the user's account and rendering the print job at the printing device." Applicant respectfully submits that the combination of Kobayashi and Olsen does not teach these claim limitations.

The Office Action acknowledges that Kobayashi fails to teach using the print subsystem to parse the spooled data and determine a layout and a number of pages of the print job, wherein the costs for the consumables is determined prior to despooling print data of the print job to the printing device; using the print subsystem component to determine an amount of available funds in the user's account; and if the amount of available funds exceeds the cost for consumables, using the print subsystem component to debit the cost of the print job from the user's account and rendering the print job at the printing device. The Office Action then relies on Olsen as teaching these claim limitations. Applicant respectfully disagrees with the proposition that Olsen teaches such limitations.

Claim 1 requires "using the print subsystem component and the parsed data to determine a cost for consumables to render the print job, wherein the cost for consumables is determined prior to despooling print data of the print job to the printing device." Olsen does not teach this limitation, as Olsen is not directed to determining the cost of consumables, but is instead concerned with protecting a secure document (such as a copyrighted document) against illicit, un-reimbursed viewing and copying. Indeed, though Olsen teaches counting pages of a document to be printed and charging for the number of pages printed, nothing in Olsen indicates that the cost represents a cost for consumables.

Olsen is directed to a system and method for ensuring secure transfer of a document.

(Title, Abstract) A primary concern addressed by Olsen is the unlimited printing and distribution of protected (i.e. copyrighted) material. (See Col 1 lines 26-30 and lines 42-45) Olsen sets forth that the pricing of the print jobs may be varied depending on who the author of the document is, or based on artists royalty fees (Col 6 lines 39-42), and may also be based on agreements between the author and reader of the document, such as copyright agreements (Col 11, lines 28-32). One of skill in the art, considering Olsen in its entirety, will readily appreciate that Olsen is addressing the protection of such rights in a document. What Olsen never discloses is any accounting based on the cost of consumables, i.e. the cost of paper (amount and type), ink, toner, binding materials, black and white vs. color, etc. (see specification as filed at page 10 lines 8-12), as is required by claim 1.

Furthermore, claim 1 requires “using the print subsystem component to determine an amount of available funds in the user’s account; and if the amount of available funds exceeds the cost for consumables, using the print subsystem component to debit the cost of the print job from the user’s account and rendering the print job at the printing device.” Olsen does not teach such limitations for the same reasons discussed above, namely Olsen does not teach any determination of a cost for consumables, and therefore does not teach a comparison between available funds and such a cost.

The Office Action fails to show any reasoning explaining why one of skill in the art would apply the rights-based cost calculations of Olsen in an entirely different and new way to arrive at calculating the costs of consumables, as is required by claim 1. Thus, the Office Action has not shown how or why one of skill in the art would overcome the differences between the teachings of the cited references and claim 1 set forth above.

For all these reasons, Applicant respectfully submits that Kobayashi and Olsen do not make the invention claimed in claim 1 obvious. Claim 29 contains similar limitations and is allowable for similar reasons. Additionally, claim 29 has been amended to require that the claimed print subsystem component that is used to authenticate the use and the user's account, to parse the spooled data, to determine the cost for consumables, and to determine the amount of available funds is a client-side device selected from the client-side spooler and the client-side print processor. Neither Kobayashi nor Olsen teach a client-side print subsystem component as is claimed in claim 29, and claim 29 is therefore allowable for at least this additional reason.

All other claims depend from one of claim 1 and claim 29 and are therefore also allowable. Applicant therefore respectfully requests removal of the rejections of claims 1, 4, 5, 8, 10, 29, 33, 35-38, and 46-48 under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi and Olsen.

Regarding the separate rejections of the dependent claims relying on combinations of Kobayashi and Olsen with additional other references, Applicant respectfully submits that none of the other cited references teach the claim limitations discussed above, either alone or in combination with Kobayashi and Olsen. For this reason alone, Applicant respectfully requests removal of the rejections of all other dependent claims under Section 103.

Furthermore, Applicant respectfully submits that there is no motivation to combine references in the manner suggested by the Office Action found in the references themselves, but that the proposed motivations are based on hindsight reasoning using Applicant's disclosure. Applicant directs the Examiner to Applicant's contentions regarding the lack of a motivation to

combine references in Applicant's previous response dated November 20, 2006, rather than restate those arguments in detail here.

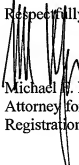
Thus, Applicant respectfully submits that for at least the reasons provided herein, the claim set as provided herein is not made obvious by the references cited by the Examiner in the Office Action.

CONCLUSION

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 26 day of November, 2007.

Respectfully submitted,


Michael S. Krieger
Attorney for Applicant
Registration No. 35,232

KIRTON & McCONKIE
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Telephone: (801) 350-7660
Facsimile: (801) 321-4893